REMARKS

Claims 1-45 were pending in this application and were subject to Restriction Requirements. No amendments are being made to the claims and thus claims 1-45 are still pending in the present application.

Restriction Requirement

Applicants thank the Examiner for making the revision to the restriction/election of species requirement.

Applicants elect claims 1-16 and 27-33, Group I, with traverse, for further prosecution in this application.

Applicants respectfully traverse the requirement for the following reasons:

The restricted claims include claims directed to a genus restricted from claims directed to species with the genus. For example, the presently elected claims include generic claim 1 (Group I) that covers all of the species in Groups III-VII, which groups are restricted by the Examiner. The claims in the restricted groups merely identify species methods within generic method claim 1 which recites:

> 1. A method of modifying a biologically active target molecule comprising contacting said target molecule with a catalyst capable of chemically modifying said target molecule, said contacting being effected under conditions sufficient for said catalyst to modify said target molecule.

Groups III-XII, for example, relate to different species of the method of claim 1 by defining the type of chemical modification occurring (e.g., by linking, by modulating the activity, by deactivating,

etc.). Thus, the claims of groups III-VII merely define specific preferred steps and the preferred modifications of the target molecules of the method of the generic claim 1. The generic methods of claims 1-16 and 27-33 (Group I) can be used to modify all of the target molecules of Groups III-VII using catalytic antibodies of claims 17-26 (Group I).

More specifically, the methods of Groups III-VI all relate to the use of a catalytic antibody catalyst (claimed in Group I, see e.g., Claim 17) to chemically modify a particular target for the treatment of a particular disease and thus also falls within the scope of generic claim 1.

Group III relates to chemical modifications of a specified target -- TNFα.

Group IV relates to chemical modifications of a specified target -- VEGF

Group V relates to chemical modifications of a specified target -- IL-4.

Group VI relates to chemical modification of a specified target -- IL-6.

The method of Group VII merely specifies the type of a chemical modification including within the scope of generic claim 1 (Group I). Namely, claim 42 (Group VII) specifies that the type of chemical modification of a target molecule is an attachment of a label. (See, Claim 42)

Applicants urge that it is improper to restrict the species falling within elected generic claim 1. Under 37 CFR 1.141, a generic claim, if allowed, may link a reasonable number of species embraced thereby. (See, MPEP 809.02) Even if the examiner rejects the generic claims, and even if the applicant cancels the same and admits that the genus is unpatentable, where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the

conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction. (See, MPEP 808.01(a)).

Therefore, the restriction is improper since it restricts claimed subject matter relating to method species falling within the scope of generic method claim 1. The MPEP clearly states:

> For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

[MPEP 803]

The Examiner has failed to establish a *prima facie* showing for the following reasons:

1. Contrary to the Examiner's assertion, the methods are closely related, as specific preferred embodiments of the generic claim 1.

2. Each of claims 1-16, 27-33 and 34-45 relate to methods falling within the scope of generic claim 1.

3. Only one field of search is required due to the close relation between the methods.

Therefore, Applicants submit that the restriction requirement is improper and should be withdrawn. The rejoinder of the Groups III-VII (claims 34-45) with Group I is respectfully requested.

Moreover, Group II, claims 17-26, merely relate to catalytic antibodies for use in the method of method claim 1 (Group I). In view of the relationship between these groups, Applicants maintain that examination of Groups II along with elected Group I would not impose an undue burden on the Examiner. In particular, a search for art related to the subject matter of Group I would reveal art related to the subject matter of Group II and vice versa. Accordingly, to require the filing of a separate divisional application directed to Group II would result in the very same search for art being repeated.

Such duplicate effort would be inefficient to the operation of the Patent and Trademark Office. Furthermore, it is likely that the same Examiner would be in charge of the divisional application, but since the divisional application would be examined at a later date, the Examiner would have to conduct a duplicate, redundant art search for the divisional application.

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims likely would result in the patent term for these claims being unnecessarily shortened.

Therefore, since the outcome of the present restriction requirement would be to delay the examination of the claims of Group II, resulting in inefficiencies and unnecessary expenditures by Applicants, and since a single search can be performed (and has been performed) for all the subject matter defined by the claims in Groups I-VII without any significant burden on the Patent Office, Applicants respectfully request reconsideration and withdrawal of the restriction requirement so that Groups I-VII will be examined on the merits together in the instant application.

If the Examiner intends or intended an Election of Species requirement under 37 CFR 1.141 for Groups I and III-VII instead of the Restriction requirement under 37 CFR 1.121, Applicants hereby elect the species of Group III for further prosecution together with Group I. Applicants expressly reserve the right to rejoin non-elected species, if the generic claims of Group I are found allowable.

Otherwise, Applicants urge the restriction is improper since it restricts into separate groups claims that are not independent and distinct and therefore should be withdrawn.

Applicants also respectfully requests the joinder of claims of Group II with the elected claims of Group I, because the examination of these groups together will not result in a significant burden on the Patent Office. Favorable reconsideration is earnestly solicited.

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Respectfully submitted,

Charles C. Achkar
Reg. No.43,311
KRAMER LEVIN NAFTALIS & FRANKEL LLP
919 Third Avenue
New York, New York 10022
Tel.: (212) 715-9100
Fax.: (212) 715-8000